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PATENT

Docket No. EHAR0004-D2

page 1

UNITED STATE PATENT AND TRADEMARK OFFICE

Re application of :
Application No. : 10/800,386
Filed : March 12,2004
For : INFORMATION CODE AND ITS
READING DEVICE

Examiner : CAPUTO, LISA M.
Art Unit : 2876

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(Date)

Jiawei Huang, Reg. No. 43,330

TRANSMITTAL OF APPEAL BRIEF

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Sir:

Transmitted herewith is an Appeal Brief in (10) pages, including (3) pages of Appendix.

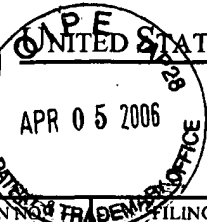
Also enclosed are:

- (X) Copy of Notification of Non-Compliant Appeal Brief.
- (X) Return prepaid postcard.
- (X) The Commissioner is authorized to charge any additional fees required, including any required time extension fee, to Deposit Account No. 50-0710 (Order No. EHAR0004-D2).

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)

APR 05 2006

Application No.

10/800,386

Applicant(s)

SAITO, TAKAHIRO

Examiner

Lisa M. Caputo

Art Unit

2876

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 01 February 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.



KARL D. FRECH
PRIMARY EXAMINER

Continuation of 10. Other (including any explanation in support of the above items): Although there exist the grounds of rejection to be reviewed upon appeal, the grounds of rejection presented are incorrect. For example, on the Table of Contents (page i) there is a reference made to a third rejection (C. Claims 3-4 as being unpatentable over Nova in view of Cozzette and Wu). Examiner respectfully submits that claims 3-4 are not pending in this application and those references were never used/cited within the case. Hence this ground of rejection is unrelated to the case, is not appropriate to be referenced, and should be removed. In addition, on page 3 of the appeal brief, reference is made to a rejection for claims 6-14 under 35 USC 102(d). Examiner respectfully submits that although it was mentioned in the Advisory Action mailed 30 September 2005 that the foreign application (exhibit A) as presented in the affidavit may qualify for a 102(d) rejection, such a rejection was never made and hence this ground of rejection should be removed from the appeal brief .



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

EX PARTE TAKAHIRO SAITO

Application for Patent

Filed March 12, 2004

Serial No. 10/800,386


**FOR:
INFORMATION CODE AND ITS READING DEVICE**

AMENDED APPEAL BRIEF

CERTIFICATE OF MAILING

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Signature: _____


JIAWEI HUANG, Reg. No. 43,380

JC PATENTS
Representative for Applicant



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I. Real Party in Interest

The real party in interest is Takahiro Saito, the inventor named in the subject application.

II. Related Appeals and Interferences

There are no related appeals and/or interferences.

III. Status of the Claims

A total of nine (9) claims 6-14 were presented during prosecution of this application. Claims 6-14 were rejected. Applicant appeals rejected claims 6-14.

IV. Status of the Amendments

Applicant filed a response after final rejection, without amending the claims and the specification, presenting a Declaration of the sole inventor and evidences to antedate the cited Ackley reference (US 6,375,075).

The Examiner indicated that the Declaration and evidences will not be entered, but stated the request for reconsideration has been considered but does not place the application in condition for allowance because:

(a). "The affidavit provided has sufficient evidence to show conception as of the applicant's foreign filing date of November 28, 1997. However, in order to be acceptable to disqualify Ackley as a 102(e) reference, diligence must be shown from the date of conception to the filing date of the Ackley reference"; and

(b). "Furthermore, examiner respectfully submits that the Exhibit A (disclosure that was filed 28 November 1997 and published 18 June 1999) as provided by the applicant would now qualify as evidence of loss of right to a patent under 35 U.S.C. 102(d) and such a rejection will be made on appeal".

V. Summary of the Claimed Subject Matter

The claimed invention relates to an information code comprising a plurality of bars shown on a product, following a predetermined pattern of arrangement according to a conventional black and white bar code structure. The bars include at least three types of bars in such a manner that each of the three types of the bars has a reflected wavelength characteristic different from that of other bars among the three types of the bars so that the reflected wavelength characteristic of the bars when combined forms a unit of displaying information.

VI. Grounds of Rejection to Be Reviewed on Appeal

A. Claims 6-8 were rejected under 35 U.S.C. 102(e) as being anticipated by Ackley et al. (US 6,375,075, hereinafter "Ackley").

B. Claims 9-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ackley in view of Yoshinaga (US 6,073,842, hereinafter "Yoshinaga").

C. Claims 6-14 were rejected under 35 U.S.C. 102(d) as anticipated by Japanese Unexamined Patent Publication No. 11-161757 (Japanese patent application No. 9-328040).

VII. Arguments

1. The related law

35 U.S.C. 104 Invention made abroad.

(a) IN GENERAL.—

(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) RIGHTS.—If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if

such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) **USE OF INFORMATION.**—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) **DEFINITIONS.**—As used in this section—

(1) The term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 6, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1993, Public Law 103-182, sec. 331, 107 Stat. 2113; Dec. 8, 1994, Public Law 103-465, sec. 531(a), 108 Stat. 4982; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent,

U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original

exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985; 53 FR 23733, June 23, 1988, effective Sept. 12, 1988; para. (a)(1) revised and para. (a)(2) added, 60 FR 21043, May 1, 1995, effective May 31, 1995; para. (a) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; heading and para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (a)(1) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

2. Remarks

A. Claims 6-8 were rejected under 35 U.S.C. 102(e) as being anticipated by Ackley et al. (US 6,375,075, hereinafter "Ackley").

Applicant traverses the rejection because the invention date of the claimed invention as established below antedates the 102(e) date of Ackley.

US 6,375,075 to Ackley was filed on October 18, 1999 (102(e) date) in this country and issued on April 23, 2002. As stated in the attached Declaration of the sole inventor, Takahiro Saito, the claimed invention of the present application was described in Japanese patent application No. 9-328040, which was filed on November 28, 1997 by the same sole inventor, Takahiro Saito, and published on June 18, 1999 as Japanese unexamined patent publication No. 11-161757. The attached Exhibit A is a true copy of Japanese unexamined patent publication No. 11-161757. Also enclosed herewith a true English translation of Exhibit A (labeled as Exhibit B). The disclosure of Japanese patent application No. 9-328040 fully supports all pending claims 6-14 of the present application. The above evidence shows that Takahiro Saito constructively reduced the claimed invention of the present application to practice on November 28, 1997 before the 102(e) date of Ackley. Therefore, the invention date of the present application antedates Ackley. Ackley should not be used as prior art of the claimed invention of the present application.

The present application is a division of U.S. patent application No. 10/424,650 filed on April 25, 2003, which claims the priority benefit of U.S. patent application No. 09/729,414 filed on December 4, 2000, which in turn claims the priority benefit of U.S. provisional application No. 60/170,815 filed on December 15, 1999. A review of the files shows that pending claims 6-14 of the present application are fully supported by the provisional application No. 60/170,815. Japanese unexamined patent publication No. 11-161757 was published on June 18, 1999

within one year from the filing date of U.S. provisional application No. 60/170,815 and, thus, does not constitute a statutory bar to the present application under 35 U.S.C. 102(b).

B. Claims 9-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ackley in view of Yoshinaga (US 6,073,842, hereinafter "Yoshinaga").

For the reasons discussed above, the Ackley reference should be removed. Withdrawal of the rejection is requested.

C. Claims 6-14 would be rejected under 35 U.S.C. 102(d) as anticipated by Japanese Unexamined Patent Publication No. 11-161757 (Japanese patent application No. 9-328040).

In the Advisory Action of September 30, 2005, the Examiner indicated that Japanese patent application No. 9-328040 would qualify as evidence of loss of right to a patent under 35 U.S.C. 102(d) and such a rejection will be made on appeal.

However, Japanese patent application No. 9-328040 was not issued into a patent in Japan before the filing date of the provisional application No. 60/170,815 of which the present application claims the priority and, thus, does not constitute a statutory bar under 35 U.S.C. 102(d).

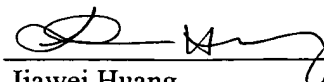
Conclusion

In view of the above discussion, Applicant believes that the rejections under 35 U.S.C. 102 and 103 are in error, and respectfully requests the Board of Patent Appeals and Interferences to reverse the Examiner's rejections of the claims on appeal.

Date: 3/31/2006

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Respectfully submitted,
J.C. PATENTS


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APPENDIX - CLAIMS ON APPEAL

Claims 1-5 (canceled)

6. (previously presented) An information code comprising a plurality of bars shown on a product, following a predetermined pattern of arrangement according to a conventional black and white bar code structure, said bars including at least three types of bars in such a manner that each of said three types of the bars has a reflected wavelength characteristic different from that of other bars among said three types of the bars so that said reflected wavelength characteristic of said bars when combined forms a unit of displaying information.

7. (previously presented) An information code according to claim 6, wherein said three types of bars include a red bar, a green bar, and a blue bar.

8. (previously presented) An information code according to claim 6, wherein said three types of bars include a white color bar and a black color bar and another bar with color selected from a color group consisting of red, blue, and green.

9. (previously presented) An information code according to claim 6, wherein said conventional black and white bar code structure includes a JAN code consisting of 13 modules, and each of the modules consists of 7 bars.

10. (previously presented) An information code according to claim 6, wherein said conventional black and white bar code structure includes a standard ITF code.

11. (previously presented) An information code according to claim 6, wherein said conventional black and white bar code structure includes a NW-7 code.

12. (previously presented) An information code according to claim 6, wherein said plurality of bars includes 13 modules, each of which consists of 7 bars and the color of said plurality of bars include black, white, a first color other than black and white, a second color other than black, white, and the first color, and a third color other than black, white, the first color, and the second color so that total $5^{(7 \times 13)}$ different information items can be expressed.

13. (previously presented) An information code comprising a plurality of bars printed on a product, following a predetermined pattern of arrangement defined by JAN code, said bars including conventional black and white bars and 3 types of bars in such a manner that each of said three types of the bars has a reflected wavelength characteristic different from that of other bars among said three types of the bars so that said reflected wavelength characteristic of said bars when combined with wavelength characteristics of said black and white bars forms a unit of displaying information.

14. (previously presented) An information code comprising:
thirteen modules,
each of said modules consisting of 7 bars, according to a predetermined pattern of arrangement,
wherein said thirteen modules including a black bar and a white bar and at least three types of other bars in such a manner that each of said three types of the bars has a reflected wavelength characteristic different from that of other bars among said three types of

the bars so that said reflected wavelength characteristic of said bars when combined forms a unit of displaying information,

wherein said thirteen modules is formed to represent 13-digit numerals, in which,

the first two digit numerals represent a national number,

the next five digit numerals a manufacturer number,

the following five digit numerals a commodity number, and

the final-digit numeral is for use in checking,

wherein said three types of bars include color bars having different colors other than black and white.